

REMARKS/ARGUMENTS

The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

The Applicant has amended Page 2 of the Specification to correct a typographical error on a granted patent number. The Applicant submits that this amendment introduces no new matter.

The Applicant has amended claims. The Applicant respectfully submits that the amendments to the claim set is fully supported by the originally filed specification.

Claim Rejections – 35 USC § 103

At page 2 of the Office Action, the Examiner rejects claims 1 to 19 under 35 U.S.C. §103 as being unpatentable over Montlick (U.S. Patent No. 5,561,446) as modified by Baldwin (U.S. Patent No. 5,884,425) in view of Ukai (U.S. Patent No. 5,696,365).

Claims 1 and 11 have now been amended to include the subject matter of claim 10 and 19 respectively specifying that the coded data is at least substantially invisible in the visible spectrum.

At page 10 of the Office Action, the Examiner rejects previous claims 10 and 19 as being unpatentable over Montlick. Reconsideration and withdrawal of this rejection is respectfully requested in light of the following comments.

Obviousness can only be established by combining or modifying teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

The Examiner has rejected claim 10 and 19 based on the disclosure of Montlick. The Examiner states that:

"[even though the information (the handwritten notes) contained in the document is unintelligible (where "substantially invisible" is considered unintelligible), to the computer, the information can be retrieved and displayed in the context which gives it meaning to a user (column 8, lines 45-48).]" (emphasis added)

It is respectfully submitted that this reasoning is illogical. The coded data is substantially invisible such that a sensing device may be used to sense the invisible coded data, and the sensed coded data is sent to the computer system. Thus, the computer system uses the sensed coded data to determine the operative use of the sensing device relative to the printed form.

Therefore, the applicant questions the reasoning that it would be obvious to modify Montlick, since the visible handwritten notes disclosed by Montlick are not intelligible to the computer, yet the claims substantially invisible coded data are intelligible to the computer.

The coded data is not visible to a user so as to allow a user to not be visually aware of the coded data whilst the sensing device is operatively used. Comparisons should not be drawn with Montlick's system which discloses visual handwritten notes which the computer cannot interpret. The common "*unintelligible nature*" of the handwritten notes and the coded data has been misconstrued by the Examiner and would not be relevant to a person skilled in the art.

We respectfully request that the Examiner reconsider the subject matter of previously presented claims 10 and 19 (now included in amended claims 1 and 11) and withdraw the rejection.

If the Examiner is not persuaded by these arguments, we further submit that a person skilled in the art would not be motivated to combine the teachings of Montlick with Ukai, in regard to claims 1 and 11.

Montlick discloses a method and system for wireless information retrieval using one or more pen-based computers. Each pen-based computer displays each retrieved form on an electronic graphical interface, and receives input from the a stylus.

The Examiner maintains in the Office Action that Montlick teaches providing a printed registration form including coded data thereon by referring to column 2, lines 63-67. However, the Examiner is misconstruing the disclosure by Montlick.

Montlick teaches the very opposite. Lines 63-67 disclose providing a digital stored registration form using an electronic screen. Montlick highlights a major deficiency of a paper based system at lines 39 to 41 of column 1:

"This information is then later transcribed by clerks using terminals so that the information can be stored for later retrieval"

Montlick teaches that a paper-based system suffer from the disadvantage of having the information transcribed, and thus being inefficient. Therefore a computerised system such as a stylus/tablet system overcomes this inefficiency.

In total contrast, Ukai teaches "a paper media system" for reading bar codes printed on a paper media with contents of a document (Abstract).

The applicant respectfully submits that there would be no motivation for one skilled in the art to modify the teachings of Montlick with Ukai. Montlick teaches a computerised method of displaying forms to overcome inefficiency suffered from paper-based forms. In total contrast, Ukai teaches using a paper media system to print a document. A person skilled in the art would not be motivated to combine Montlick with Ukai based on the teachings of Montlick in regard to paper-based systems. Montlick actually teaches the very opposite to Ukai and therefore this combination of teachings would not be obvious.

Reconsideration and withdrawal of the rejection is respectfully requested.

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections under 35 USC § 103. The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

Applicants:


PAUL LAPSTUN


KIA SILVERBROOK

C/o: Silverbrook Research Pty Ltd
393 Darling Street
Balmain NSW 2041, Australia

Email: kia.silverbrook@silverbrookresearch.com

Telephone: +612 9818 6633

Facsimile: +61 2 9555 7762